

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 31 and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by patent no. 4,205,939 to Reyes.

Regarding claim 31, Reyes discloses an unassembled mill relining apparatus, including: a mast (13 and 17) that is extendible in length so that it can be locked into a substantially upright position within a mill; a top engagement member (29 and 31) connectable or connected to the top end of the mast for engaging with an upper surface of the mill; a bottom engagement member (foot of element [17]) connectable or connected to the bottom end of the mast for resting on mill charge within the mill or a lower surface of the mill; and an article handling arrangement (not numbered, but shown in fig. 1) that is connectable to the mast so that it is supported by the mast.

Regarding claim 56, Reyes discloses an unassembled mill relining apparatus according to claim 31, wherein the mast has a base mast part (17) and an extension mast part (13) which can be coupled together to allow the extension mast part to be movable relative to the base mast part so that the length of the mast can be adjusted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reyes.

Regarding claim 34, Reyes discloses the claimed invention except for the boom being extendible in length.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the boom of Reyes extendible, since it has been held that constructing a formerly integral structure into various telescoping elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Allowable Subject Matter

Claims 1, 14-16, 18, 19, 29, 30, 39-41, 48, 50-52 and 57 are allowed.

Claims 35 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 12/20/10 have been fully considered but they are not persuasive. In response to applicant's arguments, the recitation that Reyes fails to

teach or suggest a mill relining apparatus has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIE BERRY whose telephone number is (571)272-6191. The examiner can normally be reached on Mon-Fri, 11:30-8pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saul Rodriguez can be reached on (571)272-7097. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Saúl J. Rodríguez/
Supervisory Patent Examiner, Art
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Wbj.